

REMARKS/ARGUMENTS

Claims 7-9 are pending in the current application. The specification has been objected to because the abstract contains over 150 words. Claims 8 and 9 were rejected under 35 U.S.C. 101 because the disclosed invention was inoperative and therefore lacked utility. Claim 8 and 9 were additionally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicant regarded as the invention. Claim 7 was rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,539,796 to Nakamura. Finally, claims 8 and 9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura as applied to claim 7 and further in view of U.S. Patent No. 5,372,537 to Stiles or U.S. Patent No. 6,066,035 to Hergott. Applicant respectfully traverses.

With regard to the specification, the applicant has amended the abstract so that it contains less than 150 words. Accordingly, the objection to the specification should be withdrawn.

In addition, claims 8 and 9 were rejected under 35 U.S.C. 101 as being inoperative and under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Specifically, the Applicant failed to provide antecedent basis for several items in the claims. The Applicant has amended the claims to overcome these rejections.

The Examiner also has rejected claim 7 under 35 U.S.C. 102(b) as being anticipated by Nakamura. Anticipation "requires that the same invention, including each element and

limitation of the claims, was known or used by others before it was invented by the patentee." Hoover Group, Inc. v. Custom Metalcraft, Inc., 66 F.3d 299, 302, 36 U.S.P.Q.2d 1101, 1103 (Fed. Cir. 1995). "[P]rior knowledge by others requires that all of the elements and limitations of the claimed subject matter must be expressly or inherently described in a single prior art reference." Elan Pharm., Inc. v. Mayo Foundation for Medical Educ. & Research, 304 F.2d 1221, 1227, 64 U.S.P.Q.2d 1292 (Fed. Cir. 2002) (citing In re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1571 7 U.S.P.Q.2d 1057, 1064 (Fed. Cir. 1988)). "The single reference must describe and enable the claimed invention, including all claim limitations, with sufficient clarity and detail to establish that the subject matter already existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention." Id. (citing Crown Operations Int'l, Ltd. v. Solutia Inc., 289 F.3d 1367, 1375, 62 U.S.P.Q.2d 1917, 1921 (Fed. Cir. 2002); In re Spada, 911 F.2d 705, 708 15 U.S.P.Q.2d 1655, 1657 (Fed. Cir. 1990)). See also PPG Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558, 1566, 37 U.S.P.Q.2d 1618, 1624 (Fed. Cir. 1996) (emphasis added).

Claim 7 in part requires "moving the casing hopper away from its position adjacent the casing filling station when natural casings are placed on a stuffing tube in the casing filling station." According to the Examiner, the movement of the casing hopper - at 1 is seen in Figs. 6-8, and the use of natural casings by the encasing machine is present in columns 10-11 that describe operation mode 4. The Examiner states "Figs. 6-8 show that it is inherent that the portion of the

casing hopper which allows individual feeding of the casings to the stuffing position is moveable to and away from the stuffing tube and further the retraction of the stuffing tube - 3 away from the hopper - 1 after stuffing is completed allows for the hopper to be moved away from the stuffing tube and further as seen in columns 10-11 both natural and artificial casing are shown to be capable of being used in the same operation mode and therefore the hopper can contain artificial casings while a natural casing is on the stuffing tube." The Applicant respectfully disagrees.

Inherency permits, in very limited circumstances, that an invention is anticipated by prior art that is lacking minor, well-known features in the claimed invention. Evidence of inherency "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill." Continental Can Co. USA v. Monsanto Co, 948 F.2d 1264, 20 USPQ 2s 1746, 1749-50 (Fed Cir. 1991). Inherency may not be established by probabilities or possibilities, and consequently the mere fact that a certain thing may result from a given set of circumstances is not sufficient. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). That is, the missing element or function must necessarily result from the prior art reference. Or as the Federal Circuit has stated, "[u]nder the principals of inherency, if a structure in the prior art necessarily functions in accordance with the limitations of a process or method claim of an application, the claim is anticipated." In re King, 801 F.2d 1324, 231 USPQ 136, 138 (Fed. Cir. 1986).

The Applicant asserts that the hopper disclosed in Nakamura does not necessarily move to perform its function. The Nakamura reference can operate with the hopper stationary and therefore does not necessarily have to function as the Applicant's device as claimed. Additionally, the Applicant asserts the hopper in Nakamura is fixed in a stationary position. As referenced above the examiner attempts to justify the finding of inherency by stating that Figs. 6-8 show the moving hopper. However, the Examiner fails to explain, or make clear how a movable hopper is necessarily present in the sausage encasing machine in the Nakamura reference as seen in Figs 6-8 and that it would be so recognized by persons of ordinary skill. Figs. 6, a plan view, and 8, a front elevational view, show the hopper 1 in the same position placed between the pump 5 and the linking device 12. Meanwhile, Fig. 7 does not show the hopper 1. Consequently, it is not inherent upon looking at Figs. 6-8 that the hopper 1 is necessarily moveable.

Additionally, within the specification there is no disclosure that the hopper moves. Rather, the only disclosure regarding the hopper is that "[t]he apparatus will continue to operate until all casings in the casing hopper 1 are stuffed with sausage dough and twisted into linked sausages and then will automatically be stopped." Col. 10, lines 21-24.

To further illustrate that there is no need for the hopper in Nakamura to move, one need only look at how the present invention and the Nakamura device are altered to receive the natural casings. In the present invention a collar 200 is slidably mounted on the stuffing tube 16 at a place underneath the hopper 46 and thus the hopper must be

moved to place the collar 200 on the stuffing tube 16. See Page 8-9 and Figs. 3 and 3A. The Nakamura device produces soft natural casings in operation mode 4. See Col. 10 lines 30-33. The Nakamura device is altered by mounting the guide bar 37 to the frame F, and by coupling the arm 40 of slide sleeve 39 to the arm 41a of coupling 41. See Col. 10 lines 34-41. Then the "same procedure as that in operation mode 2" is used. Col. 10 lines 34-41. In Figs. 6-8, guide bar 37, arms 40 and 41a, coupling 41 and slide sleeve 39 are all located a distance away from the hopper 1 and not underneath the hopper 1. Consequently, the hopper 1 does not need to be moved to change the machine to accommodate natural casings.

Therefore, because the only two figures that show the hopper 1, Figs. 6 and 8, present the hopper in the exact same location, because nothing in the specification discusses the movement of the hopper, and because the hopper does not need to be moved to change the encasing machine so that it is capable of filling natural casings, in contrast to the Examiner's belief, the Applicant submits that the hopper of Nakamura does not necessarily move and therefore movement is not inherent. Because the hopper 1 of Nakamura does not move as is required by claim 7, each and every element of claim 7 is not present and the Examiner's rejection cannot stand.

Claims 8 and 9 were rejected under 35 U.S.C. 103 as being anticipated by Nakamura in view of Stiles or Hergott. Claims 8 and 9 are dependent on claim 7 and because claim 7 is in allowable form, claims 8 and 9 are additionally in allowable form.

CONCLUSION

In view of the above amendments and remarks, Applicant believes claims 7-9 are in condition for allowance and respectfully requests allowance of such claims. If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515/558-0200.

Any fees or extensions of time believed to be due in connection with this amendment are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 50-2098.

Respectfully submitted,



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